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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/589,757

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EXAMINER

KAYES, SEAN PHILLIP

ART UNIT

PAPER NUMBER

2833

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/589,757	<b>Applicant(s)</b> PEREZ, ANTONIO	
	<b>Examiner</b> SEAN KAYES	<b>Art Unit</b> 2833	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 August 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “assembly member is constructed in such a way as to allow said movement to rotate in its housing” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

2. The specification and claims 1-6 are objected to for failing to comply with the enablement requirement.

3. With regard to claims 1-6 the specification does not enable one of ordinary skill in the art to understand how to arrange the movement inside of the housing and how to construct/use “an assembly member connecting said movement to said case” as recited in claim 1. The specification makes numerous references to items in the drawings which are not depicted. Most applicable to issue at hand the specification refers to the movement as able to rotate freely inside the housing. However, as depicted in figure 2 and discussed on page 3 lines 17-20 the movement is attached to the housing by means 22 figure 2. Said attachment is achieved with screws 22b and 22c.

Subsequently, the movement would be attached in a fixed, non-rotating manner.

However, this interpretation would be in contradiction with the disclosure of lines 17-20 page 3, particularly line 20. Lines 17-20 page 3 further state that the arrangement/connection between the movement and housing is achieved by connecting element 22a is connected to element 12a. However, these elements are not depicted.

4. One of ordinary skill in the art would be enabled by the scope of their experiences as one of ordinary skill in the art of Horology to construct and/or design a means to secure a case to a movement in a fixed (non-rotating) manner without any supporting disclosure. However, applicant's disclosure directly contradicts (as detailed above) such a support structure easily obtainable by one of ordinary skill in the art.

Subsequently, one of ordinary skill in the art would be disenabled by the disclosure of

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applicant's invention to achieve the limitation of a movement arranged inside said housing, in accordance with applicant's invention as recited in claim 1.

5. Similarly with regard to claims 2-5, one of ordinary skill in the art would not be enabled by the disclosure to make or use the device claimed in claim 2 particularly "wherein said assembly member is constructed in such a way as to allow said movement to rotate in its housing." There is no disclosure of elements capable of performing this claimed subject matter.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Grau (US 6896403.)

8. With respect to claim 1 Grau discloses a watch comprising:

- a case (2 figure 1) defining a housing,
- a movement (41-44 figure 2) arranged inside the housing,
- display organs (10, 12, and 16 figure 1) carried by said movement (41-44 figure 2),

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- an assembly member (dial figure 1) connecting said movement (41-44 figure 2) to the case (2 figure 1), and
- a control system (SS0 figure 1) accessible from outside said case (2 figure 1) intended for correcting the display organs (10, 12, and 16 figure 1) in which watch the assembly member (dial figure 1) allows the movement (41-44 figure 2) to be displaced with reference to the case (2 figure 1), and the movement comprises a correcting mechanism (30 figure 1; 25 figure 3; and 5-8 figure 6-9) for correcting the display organs (10, 12, and 16 figure 1),
- said assembly member ( ) being so constructed that, in at least one predefined position of said watch,
- said movement (41 figure 2) occupies a defined position (center figure 1) in its housing, and in that said control system (SS0 figures 1-2) comprises:
  - a button (21 figure 3) accessible from outside said case (2 figure 1) and capable of being displaced by an application of pressure toward said movement from an initial position,
  - a stem (20 figure 3) attached to said button (21 figure 3) and passing through said case (2 figure 1), and
  - a connecting member (3, 4, and 24 figure 3 and 103 figure 9) designed to connect said button (21 figure 3) to the correcting mechanism (30 figure 2 and 5-8 figure 6-9) and constructed in such a way that, on the one hand, said stem is situated at a distance from said connecting member when said button is in said initial position and, on the other hand, said stem can be connected to said

connecting member, in said defined position, in response to said application of pressure to said button (21 figure 3).

9. Claims 1, 2, and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Oomori (US 7025494.)

10. With respect to claim 1, Oomori discloses a watch comprising :

- a case (101 figure 1) defining a housing,
- a movement (102 figure 1) arranged inside the housing,
- display organs (103 figure 1 and 8) carried by said movement (),
- an assembly member (25 figure 6 and/or central stem depicted in figure 8) connecting said movement (102 figure 1) to the case (101 figure 1), and
- a control system (4 figure 1) accessible from outside said case (8 figure 1) intended for correcting the display organs (103 figure 1) in which watch the assembly member (25 figure 6 and/or center stem depicted in figure 8) allows the movement (102 figure 1) to be displaced with reference to the case (101 figure 1), and the movement comprises a correcting mechanism (116 figure 1) for correcting the display organs (103 figure 1), said assembly member (25 figure 6 and/or the central stem depicted in figure 8) being so constructed that, in at least one predefined position of said watch,
- said movement (102 figure 1) occupies a defined position (see figure 8) in its housing, and in that said control system comprises:

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- a button (8 figure 1) accessible from outside said case (101 figure 1) and capable of being displaced by an application of pressure toward said movement from an initial position,
- a stem (4 figure 1) attached to said button (8 figure 1) and passing through said case (101 figure 1), and
- a connecting member (14, 18, and 116 figure 1) designed to connect said button (8 figure 1) to the correcting mechanism (116 figure 1) and constructed in such a way that, on the one hand, said stem is situated at a distance from said connecting member when said button is in said initial position and, on the other hand, said stem can be connected to said connecting member, in said defined position, in response to said application of pressure to said button (see figures 6 and 7.)

11. With respect to claim 2, Oomori discloses the watch as claimed in claim 1, characterized in that said assembly member (25 and/or center stem depicted in figure 8) is constructed in such a way as to allow the movement (102 figure 1) to rotate in its housing (see the direction arrows of figure 8.)

12. With respect to claim 6, Oomori discloses the watch as claimed in claim 1, characterized in that the case (101 figure 1) has a tube (14 figure 1), engaging with the button (8 figure 1) and with the stem (4 figure 1) attached to the button, and a seal (119



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and 20 figure 1), between the button (8 figure 1) and the tube (14 figure 1), for sealing the passage of the stem (4 figure 1) through the case (101 figure 1.)

13. Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Miyauchi (US 6349075.)

14. With respect to claim 1, Miyauchi discloses a watch comprising :

- a case (11 figure 3) defining a housing,
- a movement (3, 36; and 49, 47, 44, 45, ect. figure 4) arranged inside the housing,
- display organs (13 figure 3) carried by said movement,
- an assembly member (pivots, i.e. 4 figure 4) connecting said movement (1, 3 and 36 figure 4) to the case (10 figure 3), and
- a control system (31 figure 4) accessible from outside said case (10 figure 3) intended for correcting the display organs (13-15 figure 3) in which watch the assembly member (pivots, i.e. 4 figure 4) allows the movement to be displaced with reference to the case (10 figure 3; 20 figure 4), and the movement comprises a correcting mechanism (33 figure 4) for correcting the display organs (13-15 figure 3),
- said assembly member (pivots, i.e. 4 figure 4) being so constructed that, in at least one predefined position of said watch,
- said movement (36 and 3 figure 4) occupies a defined position (figure 4) in its housing, and in that said control system (31 figure 4) comprises:

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- a button (31 figure 4; 11c figure 3) accessible from outside said case (10 figure 3) and capable of being displaced by an application of pressure toward said movement from an initial position,
- a stem (31 figure 4) attached to said button (11c figure 3) and passing through said case (10 figure 3; 20 figure 4), and
- a connecting member (33 figure 4) designed to connect said button (11c figure 3) to the correcting mechanism (33 and 35 figure 4) and constructed in such a way that, on the one hand, said stem is situated at a distance from said connecting member when said button is in said initial position and, on the other hand, said stem can be connected to said connecting member, in said defined position, in response to said application of pressure to said button (31, 33 and 36 figure 4; column 6 line 61 through column 7 line 2.)

15. With respect to claim 2, Miyauchi discloses the watch as claimed in claim 1, characterized in that said assembly member (pivots, i.e. 4 figure 4) is constructed in such a way as to allow the movement (36 and 3 figure 4) to rotate in its housing.

16. With respect to claim 4, Miyauchi discloses the watch as claimed in claim 2, characterized in that the movement (4 figure 4) is encircled by a weighted ring (3 figure 4) and constructed in such a way as to define an eccentric mass (2 figure 4 and abstract) causing the movement (4 figure 4 provides the power in order for the entire movement to rotate in the housing) to rotate in its housing.

***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyauchi (US 6349075) in view of applicant's admitted prior art.

19. With respect to claim 3, Miyauchi discloses the watch as claimed in claim 2, characterized in that said movement (3 figure 4) is of automatic type.

Miyauchi does not teach its rotation winding up its driving spring. Applicant states in the second paragraph of applicant's disclosure states that it is known to wind up a spring by means of an eccentric weight.

At the time of the invention it would have been obvious to one skilled in the art to configure Miyauchi's device to further charge a mainspring. The reason for doing so would be to provide Miyauchi's device with an additional power source/storage means.

***Response to Arguments***

20. Applicant's arguments filed 3/28/2008 have been fully considered but they are not persuasive.

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21. The amendments to the drawings remedy most, but not all of the objections. As stated above there is still no depiction of an "assembly member is constructed in such a way as to allow said movement to rotate in its housing".

22. Applicant states that the examiner's interpretation of the specification is incorrect as evidenced by page 3 line 19-20. This citation recites "The movement 12 is thus able to rotate in its housing about the pivot axis of the plate 12a." This argument is not persuasive. There is no depicted pivot or pivot axis or pivot means of any kind. There is depicted a plate and screw attaching means.

23. Applicant asserts that Grau, Oomori, and Miyauchi fail to teach the limitations of claim 1 because the elements are all fixed. This argument is not persuasive. Grau, Oomori, and Miyauchi all teach elements which move relative to a case.

24. Applicant asserts that even motors 41-44 of Grau are fixed. This argument is not persuasive. A motor by definition must be capable of rotational movement. The central shafts for instance must rotate as thus move relative to the case as required by the claims.

25. Applicant asserts that Grau, Oomori, and Miyauchi fail to teach a button. This argument is not persuasive. See figure 6-7 of Oomori, Figure 1 of Grau, and figure 3 of Miyauchi.

26. Applicant asserts that a prima facie case of obviousness has not been established. Applicant continues to provide a general discussion of the requirements of prima facie obviousness, see MPEP 2142, but fails to explain how the previous rejection is deficient under this discussion.

Contrary to applicant implications a proper articulation of the reasons for rejection has been set forth. The rejection states:

“At the time of the invention it would have been obvious to one skilled in the art to configure Miyauchi's device to further charge a mainspring. The reason for doing so would be to provide Miyauchi's device with an additional power source/storage means.”

### ***Conclusion***

27. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SEAN KAYES whose telephone number is (571) 272-8931. The examiner can normally be reached on 11:00am to 9:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tulsidas Patel can be reached on (571) 272-2098. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Felix O. Figueroa/  
Primary Examiner, Art Unit 2833

SK  
7/9/2008